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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/634,498

08/05/2003

Randall Woods

27593CIP

7062

33357 7590 04/05/2010
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EXAMINER

MATTHEWS, WILLIAM H

ART UNIT

PAPER NUMBER

3774

MAIL DATE

DELIVERY MODE

04/05/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/634,498	Applicant(s) WOODS ET AL.	
	Examiner William H. Matthews (Howie)	Art Unit 3774	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 February 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 32,33,35,38-54 and 56-72 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 32,33,35,38-54 and 56-72 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

Applicant's arguments with respect to claims 32-33,35,36,38-54,56-69 have been considered but are not persuasive.

Applicant argues 1) the device of Horn is configured to replace the zonules, and be responsive to the ciliary muscles, rather than be responsive to the zonules as claimed, 2) the arms 84 of Horn relax rather than move/push inward, and 3) Horn is not configured for placement in the capsular bag thus is not combinable with the with Hanna or modifiable to provide a different (wider) positioning member as proposed by Examiner.

Issues 1) and 2) are similar, in that Applicant argues Horn *teaches away* from the intended use and modification (Remarks page 11, lines 4-5). Examiner disagrees because Horn's primary object is to provide implantable lenses which are responsive to the natural eye contraction/relaxation functions, unlike the prior art at the time of Horn's invention (c1:7-8,c2:21-27). Thus, the modifications as proposed by Examiner in the 103 rejection do not destroy the intended purpose of Horn. Rather, the object of Horn's invention is preserved while the lens of Horn is merely modified for use such that the zonules and capsular bag remain intact. In fact, Horn describe the invention for cataract surgery (c1:7-8), and Hanna teach his invention for cataract surgery when portions of the capsular bag are left intact.

With further respect to 1), the limitations at issue are of intended use. The device of Horn is fully capable of use as claimed. Applicant has not shown the Horn device to

Art Unit: 3774

be incapable of use as claimed in all eyes, rather Applicant has suggested only that the diameters of Horn's device and the Applicant's device would be different for the same individual patient based upon the intended use of each disclosure.

With respect to issue 2), Applicant argues the relaxation of arms 84 in Horn do not move inwardly or push inwardly. Examiner disagrees because the arms do in fact move inwardly (or push inwardly toward the optic). Horn discloses the arms to be under tension, or a stretched state. The arms must, in effect, move inwardly as they relax in order to achieve the optic shape change involving a greater thickness. A rubber band that is stretched moves inwardly as the rubber band is relaxed. If the rubber band is acted on by an external structure (e.g. a person's fingers or the ciliary muscle) to relax the rubber band, portions of the rubber may be considered to push inwardly (claim 72).

Claim Objections

Claims 48-52 are objected to because of the following informalities: the limitation "for any accommodative state" is unclear if the claim refers to "all" states or the states having the shape changes (as required by claim 56). For purposes of examination Examiner interprets the limitation to be similar to claim 56 as the specification do not appear to describe "all states". Applicant is advised to amend the claim to be in compliance with the original disclosure and/or claim 56.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 53-54,58,59,66-68 are rejected under 35 U.S.C. 102(b) as being anticipated by Horn et al. USPN 4888012 ("Horn").

Horn disclose in figures 4-6 an intraocular lens comprising arms 84 and legs 44, collectively forming the outer body of a positioning member surrounding optic lens 12. Accommodation is achieved via external forces causing a shape and curvature of the optic to change. The optic may be formed of gel or liquid material.

The lens is sized for use as claimed, as the overall diameter of one device is inherently capable of matching ciliary muscles of a certain patient or zonules of a patient having smaller eyes (a child or smaller animal, for example), and arms 84 are capable of moving inward whether by being pushed or relaxed (constriction of arms 84 still moves the material of the arm radially inward).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

Art Unit: 3774

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 32-33,35-36,38-52,56-57,60-65,69-72 are rejected under 35 U.S.C.

103(a) as being unpatentable over Horn et al. USPN 4888012 ("Horn") as applied to claims 53-55,58,59,66-68 above and in further view of Hanna USPN 6749634.

Horn is described supra. With respect to claims 32, 44, 47, 48, 51, 52, 56, and 57, Horn is silent as to providing the optic between the planes, an opening anterior to the optic, an opening behind the optic, an annular portion anterior of the optic, and anterior/posterior segments located anteriorly/posteriorly of the optic. Hanna discloses an accommodating lens system for placement in the capsular bag wherein the outer body of the positioning member comprises anterior and posterior segments located anterior and posterior of the optic and comprises openings anterior and posterior of the optic such that the optic is between planes as claimed. The positioning member is shaped to conform to a capsular bag.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the positioning member of Horn to include anterior and posterior segments located anteriorly and posteriorly of the optic as taught in Hanna in order to provide the lens system with a configuration for placement in the capsular bag. Both devices are disclosed to accommodate in response to the natural eye muscle function and are considered analogous art.

Regarding claims 42,43 and 49, Hanna and Horn are silent as to the dimension along the optical axis and the diopter power of the lens. However, Hanna and Horn are directed to accommodating implants which are adapted to treat a wide range of

Art Unit: 3774

patients. Therefore it would have been obvious to one of ordinary skill in the art to select the particular sizes and optical powers in order to fit a particular patients needs. Furthermore, the claimed ranges are well within ranges known in the art and would thus be a matter of obvious design choice.

Conclusion

All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William H. Matthews (Howie) whose telephone number

Art Unit: 3774

is 571-272-4753. The examiner can normally be reached on Monday-Friday 10-6:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David J. Isabella can be reached on 571-272-4749. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/William H. Matthews/
Primary Examiner
Art Unit 3774